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09/846,565	04/27/2001	R. Edward Winters		4126

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EXAMINER

MILLER, CHERYL L

ART UNIT PAPER NUMBER

3738

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/846,565

Applicant(s)

WINTERS, R. EDWARD

Examiner

Cheryl Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection, and after petition granted to revive the abandonment. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 23, 2006 has been entered.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

Claims 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 positively recites a portion of the body (vessel/tube and diameter of the aperture/vessel) as part of the device, which portions of the body are considered non-statutory subject matter. It is suggested to change, "are inserted into a flexible tube at a target site" to recite, --are adapted for insertion into a flexible tube at a target site--. It is also suggested to change, "diameter is larger than said target site" to recite, --diameter is sized (or configured) to be larger than a target site--.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. All claims refer to a first and second axis. However, in each configuration, only one axis is present. Axis, is defined by its plain meaning, a *straight* line dividing a body into symmetrical parts. In the first unexpanded configuration, only a first axis exists (because the first axis is then straight and the second configuration does not exist yet). In the second configuration, only the second axis exists (because the second axis is straight, the prior first axis is no longer straight and may not be termed an axis). As claimed, it is unclear to the examiner, which configuration is being claimed, the starting or the final. Either way, 2 axes may not exist at one time according to the applicants drawings.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al. (US 6,093,199, cited previously). Brown discloses an expandable hoop support (10; all figs.) and procedure for opening an artery substantially as claimed. Brown discloses a preformed hoop stent (10) composed of a coil of material disposed about a first axis (not shown in figs. however disclosed at col.4, lines 48-50; primary coil) and about a second axis (secondary coil; col.4, lines 50-53; shown in figs.) and the coil having memory (fig.1A; col.3, lines 12-19) and a cylindrical

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delivery means to constrain coil into a linear configuration (col.8, lines 62-65), the delivery means being either a rod fit within the coil (over a guidewire, col.3, lines 21-24; col.4, lines 65-67) or a tube fit over the coil (through a catheter, col.3, lines 21-24; col.8, lines 62-65), and wherein when delivery means is removed in an artery (or flexible tube, as claimed in claim 1 and 8), coil reconfigures into an original preformed configuration (col.3, lines 21-27; col.4, lines 48-67; col.8, line 62-col.9, line 16). Brown's stent is adapted to hold open the vessel (see all figs).

Claims 1, 3-5, and 7-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Farzin-Nia (US 6,818,076 B1). Farzin-Nia discloses an expandable hoop support (fig.2) and procedure for opening an artery substantially as claimed. Farzin-Nia discloses a preformed hoop stent (col.3, lines 47-50; col.2, line 4) composed of a coil of material (multi-filar strands 12) disposed about a first axis (forming strand 10; primary coil) and about a second axis (secondary coil; windings 14) and the coil having memory (col.2, lines 49-55) and a cylindrical delivery means to constrain coil into a linear configuration (catheter/guidewire; col.3, lines 17-25), and wherein when delivery means is removed in an artery (or flexible tube, as claimed in claim 1 and 8), coil reconfigures into an original preformed configuration. Farzin-Nia's stent is adapted to hold open the vessel (col.3, lines 47-50).


### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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